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EXAMINER				
HORNING, JOEL G				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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# Office Action Summary

**Application No.**

10/558,384

**Applicant(s)**

GOTO ET AL.

**Examiner**

JOEL G. HORNING

**Art Unit**

1792

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 04 December 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 60-143 is/are pending in the application.
- 4a) Of the above claim(s) 60-89 and 116-143 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 90-115 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-8508)  
Paper No(s)/Mail Date See Continuation Sheet
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

Continuation of Attachment(s) 3. Information Disclosure Statement(s) (PTO/SB/08), Paper No(s)/Mail Date :07-13-2009;03-27-2009;09-05-2006;11-29-2005.

## **DETAILED ACTION**

### ***Election/Restrictions***

1. **Claims 60-89 and 116-143** are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected inventions, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 12-04-2009. Claims 90-115 are currently undergoing prosecution on their merits.

The traversal is on the ground(s) that because the claims do not currently limit the materials of the electrode, there is currently no examination and search burden and so the restriction is "premature and without merit at this time in prosecution." However, this is not found persuasive because the examiner has determined that there is an examination and search burden for these patentably distinct species due to their mutually exclusive characteristics and in the interest of compact prosecution, this species election is being made now. Furthermore, the examiner believes that if a claim generic to this election is found allowable, the issuing patent will be valid for the scope of the generic claim and not be limited to only this elected species, which is made only for the purposes of examination.

The requirement is still deemed proper and is therefore made FINAL.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. **Claims 90-115** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The term "uniform" in **claims 90, 95, 100, and 108** is a relative term which renders the claim indefinite. The term "uniform" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. These electrodes are formed of compressed powders, so they are at least composites of air and the materials of the powder, and so will have open pore regions and solid regions. This is non-uniformity in the electrode. Additionally, applicant's claims are written to include the possibility of using other powders (e.g. from claim 90, "formed with a powder comprising a metallic powder or a metallic compound powder"), so the non-uniformities that result in using different powders must be considered to still be uniform. For the purposes of examination, the electrode will be considered "uniform" at least if the powders are mixed without intentionally structuring them into layers or bands of different compositions, so that the non-uniformities that result from having an air/powder composite or using different powders will not be considered sufficient to produce non-uniform electrodes.

3. **Claims 104 and 112** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In particular, these claims require that "the

powder is any one of Co alloy, Ni alloy, and Fe alloy." However, the independent claims they refer to require the presence of two different powders, so it is uncertain which one, either or both are required to be these alloys. For the purpose of examination, this will be interpreted to mean that one of the powders be one of these alloys.

4. **Claims 91-94, 96-99, 101-107 and 109-115** are rejected for being dependent upon these rejected claims, and so incorporating their indefiniteness.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. **Claims 90 and 95** are rejected under 35 U.S.C. 102(b) as being anticipated by Saito (Japanese Patent Application Publication Number 05 – 148615, hereafter Saito, using the machine translation thereof).

Saito teaches an electrical-discharge surface-treatment method for forming a coat on a surface of a workpiece using the energy of a pulsed electrical discharge between a green discharge electrode and the workpiece (see, e.g. Paragraphs [0017] – [0019]), the electrode is formed by mixing the desired material powders (they are mixed so they are uniform), such as iron metal powder with an average diameter of 3 micrometers, and compression molding them to form a green compact, which is used as the electrode to deposit a layer, which could be used for machining,

on a work piece [0027]. The coating process takes place in a medium which could be used for machining, e.g. a gas [0014]. Saito teaches that while other processes had difficulty depositing layers of about 100 micrometers thick, their process solves this problem, and so is capable of forming layers 100 micrometers thick (**claim 90**) [0006-0008].

6. **Claim 95** requires that the electrode have a uniform hardness (which it is clearly envisaged will be present from the powders being mixed without forming particular structures) and that the (e.g. 3 micrometer) powder be not less than 10% of the powder in the electrode. Saito teaches that the 3 micrometer powder is 50% (1:1 ratio) of the powder (**claim 95**) [0027].

#### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

7. **Claims 91-99** are rejected under 35 U.S.C. 103(a) as being unpatentable over Saito in view of Imai et al. (Japanese Patent Application Publication Number 11 – 229159, hereafter Imai, using the machine translation thereof).

**Claim 91** further requires that the powder have an average value of particle diameter not less than 10 nanometers and not more than 1 micrometer.

While Saito does not teach a metallic compound powder having an average grain diameter in this range, it does teach that the metallic compound powder that forms the electrode has a mean particle/grain diameter of 3 micrometers [0027].

However, Imai teaches a discharge coating method in which the particle diameter of a green compact electrode is a result-effective variable that is known to influence both the thickness and quality of the film produced [0020]. Specifically, Imai teaches a relation of discharge processing energy (discharge processing condition) when using a green compact electrode comprising different particle diameters and further addresses a relation between the discharge processing energy and a film thickness of a surface process layer. When the particle diameter is for example 1  $\mu\text{m}$ , the film thickness increases with the discharge processing energy used when the particle diameter is 5  $\mu\text{m}$ , but with deterioration of surface properties. Imai is explicitly teaching that the quality and thickness of a deposited film can be controlled by varying the result-effective variables of grain diameter and discharge energy (which is itself a function of pulse width and pulse current) in electrical-discharge surface-treatment methods, and that electrodes comprising metal compound powders and powders with grain diameters on the order of 1  $\mu\text{m}$  are



known to be used in the successful deposition of films by optimizing these variables (see Paragraphs [0014], and [0016] – [0020] and elsewhere). It has been held that, "where the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation." *In re Aller*, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955). Therefore, it would have been obvious to one having ordinary skill in the art at the time of the present invention to have modified the method taught by Saito by using a green compact electrode that is formed with a metallic compound powder having an average value of particle diameter not less than 10 nanometers and not more than 1 micrometer as taught by Imai in order to have optimized the desired characteristics (thickness, quality) of the deposited film as taught by Imai (**claim 91**).

8. **Claim 92 and 97** further require that the electrode and work piece be arranged in a machining fluid or predetermined gas atmosphere. Saito teaches performing its discharge process in a gas atmosphere, so the deposition components must have been arranged in that atmosphere [0014].
9. Regarding **claims 93 and 98**, Saito teaches performing the process under exemplified conditions of a width of a current pulse for the pulsed electrical discharge of 16 microseconds and a peak of the current pulse of 20 amperes (see Paragraph [0028]). Saito further teaches that appropriate pulse widths are between 5-2000 microseconds and appropriate amperages are 1-100A, which overlaps with applicant's claimed ranges. MPEP 2144.05 states: "In the case where the claimed

ranges "overlap or lie inside ranges disclosed by the prior art" a prima facie case of obviousness exists."

10. Regarding **claims 94 and 99**, Saito teaches using an iron metal powder [0027].
11. **Claim 96** further requires that 80% of the powder in the electrode be of the powder that has an average diameter of 10-1000nm. Saito alternately teaches making the electrode from a single aluminum metal powder (100%>80%) [0024], and as discussed for claim 91, it is obvious to control the diameter of the powder particles to have average values between 10-1000nm.

Thus it would have been obvious to a person of ordinary skill in the art at the time of invention to make an electrode with greater than 80% of the powder having average diameters of 10-1000nm.

12. **Claims 100, 102-108 and 110-115** are rejected under 35 U.S.C. 103(a) as being unpatentable over Saito.

Regarding **claim 100**, this independent claim has limitations from claim 90, but further requires that there be two powders present, one with smaller diameter particles and another with larger diameter particles at least twice that of the small diameter powder. The 5-60 vol% of the powder is the larger powder.

Saito teaches using a powder composed of a smaller powder with an average diameter of 3 micrometers and a larger powder with an average diameter of 9.8 micrometers, where the larger particle is 50% of the mixture [0027]. It is uncertain whether the percentage in Saito is a volume percent. However, MPEP 2144.05 (II) states: "Generally, differences in concentration or temperature will not support the

patentability of subject matter encompassed by the prior art unless there is evidence indicating such concentration or temperature is critical. "[W]here the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation." Thus it would have been obvious to a person of ordinary skill in the art at the time of invention to use a powder with 5-60vol% being the larger powder by routine experimentation (**claim 100**) or even a powder with 5-20vol% being the larger powder by routine experimentation (**claims 105 and 113**).

13. Regarding **claims 102 and 110**, since the particles of Saito can be adequately described only by a single diameter [0027], it is readily apparent that they are substantially spherical.

Alternatively, Saito discloses the claimed invention except for that the particles are substantially spherical. It would have been an obvious matter of design choice to choose substantially spherical particles, since such a modification would have involved a mere change in the size of a component. A change of size is generally recognized as being within the ordinary level of skill in the art. *In re Dailey*, 357 F.2<sup>nd</sup> 669, 149 USPQ 1966.

14. Regarding **claims 103, 104, 111 and 112**, Saito teaches that a wide variety of materials can be used in their method, including alloys and carbides. Hard carbides like titanium carbide can be used. For corrosion resistance, metallic materials, such as Ti, Ni or Co can be included. For higher conductivity, Fe, Co, Ni, Cr, or Cu can be included [0016]. Saito further teaches in this paragraph that "as covering

material, various metallic elements ... are possible, for example, they are metal or an alloy, a nonmetallic element, ceramics, carbide, ... What is necessary is in short, just to choose material due to the surface characteristic made to give." Therefore Saito is teaching that it is known to vary the components of these electrodes, in order to affect and change the surface composition and characteristics of the produced layer. Saito does not specifically teach using two powders that contain an identical component or using an alloy of Co, Ni or Fe for one of the powders.

However, from this teaching it would have been obvious to a person of ordinary skill in the art at the time of invention to use a combination of powders (e.g. TiC powder and titanium metal powder) in order to produce a desired material characteristics in the produced film (e.g. a film of good hardness and corrosion resistance) (**claims 103 and 111**).

Furthermore, it would have been obvious to a person of ordinary skill in the art at the time of invention following the teaching of Saito to alloy a powder of Co, Ni or Fe for use as one of the powders (e.g. FeAl), in order to produce desired surface characteristics in the deposited material that would result from the chosen alloy (e.g. good conductivity and corrosion resistance) (**claim 104 and 112**).

15. Regarding **claims 106 and 114** as discussed previously in the rejections of claims 92 and 97, this is taught by Saito.
16. Regarding **claims 107 and 115** as discussed previously in the rejections of claims 93 and 98, this is taught by Saito.

17. **Claim 108** has the limitations of claim 100, but further requires that there be a distribution of smaller diameter powder be not more than 3 micrometers in diameter and that the average diameter of the larger diameter powder be not less than 5 micrometers in diameter. As discussed for claim 100, Saito teaches this.
18. **Claims 101 and 109** are rejected under 35 U.S.C. 103(a) as being unpatentable over Saito in view of Imai (Japanese Patent Application Publication Number 11 – 229159, hereafter Imai, using the machine translation thereof) further in view of Koizumi et al (EP 1035231, hereafter referred to as Koizumi).

Saito in view of Imai does not specifically teach that the smaller powder is refined by grinding.

However, Koizumi is also directed towards an electrical-discharge surface-treatment method for forming a coat on a surface of a workpiece using the energy of a pulsed electrical discharge between a green discharge electrode and the workpiece (abstract). It teaches that the powders used can be suitably formed by grinding (pulverizing) them [0031]. Thus it would have been obvious to a person of ordinary skill in the art at the time of invention to grind the powder in order to produce the desired size of powder particle, since it was a method known to be suitable for the refining of powders to be used in such green discharge electrodes and would produce predictable results (**claims 101 and 109**).

#### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory

obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

**19. Claims 90-99** are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-7 of U.S. Patent No. 7641945 (hereafter referred to as '945). Although the conflicting claims are not identical, they are not patentably distinct from each other because it teaches an electrical-discharge surface treatment using a green electrode that has been compressed formed of a metallic powder or metallic compound powder with average particle diameters that are not greater than a micrometer (overlapping with the claimed range). The discharge treatment forms a film of a machining material on a work piece surface. Since there must be a gap between the electrode and the work piece to form the discharge, there must be a machining medium to fill it. This process is capable of forming films 100 micrometers in diameter. From the claims the use of a single powder to form the electrode is clearly envisaged, so the electrode will be uniform in composition and the powder will certainly be more than 10% of the

powder. The current pulse is not more than 70 microseconds and the current is less than 30 amps.

20. **Claims 100, 102-108 and 110-115** are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-7 of U.S. Patent No. 7641945 in view of in view of Saito.

'945 does not teach using different powders of the required diameters, compositions and proportions. However, as discussed in the rejection of claims 100 previously, Saito makes these limitations obvious, so it would be obvious to a person of ordinary skill in the art to modify '945 to produce these limitations in view of Saito (**claims 100, 102-106, 108 and 110-114**). '945 further teaches performing the discharge with a pulse width which is less than 70 microseconds and at less than 30 amps (**claims 107 and 115**).

21. **Claims 101 and 109** are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-7 of U.S. Patent No. 7641945 in view of in view of Saito in view of Koizumi.

'945 in view of Saito does not teach grinding the powders to produce the desired refined size, however, as discussed in the rejection of these claims above, Koizumi teaches grinding the powders and so renders it obvious to a person of ordinary skill in the art at the time of invention to use powders that have been ground, since they were known to be suitable and would produce predictable results.

22. **Claims 90, 95, 100, 102-106, 108 and 110-114** are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable

over claims 76-78, 105 and 106 of copending Application No.10/559427 (hereafter referred to as '427) in view of Saito. Although the conflicting claims are not identical, they are not patentably distinct from each other because these claims teach the limitations of claims 90 and 95 except for explicitly stating that the electrode is uniform, the particle diameter is 10-3000nm in diameter and that the process is capable of forming 100micron thick films.

This process is capable of forming films 100 micrometers in diameter. From the claims the use of a single powder to form the electrode is clearly envisaged, so the electrode will be uniform in composition and the powder will certainly be more than 10% of the powder.

'427 does not teach using different powders of the required diameters, compositions and proportions. However, as discussed in the rejection of claims 100 previously, Saito makes these limitations obvious, so it would be obvious to a person of ordinary skill in the art at the time of invention to modify '427 to produce these limitations in view of Saito (**claims 90, 95, 100, 102-106, 108 and 110-114**). As discussed in the prior art rejection of claims 107 and 115, Saito teaches performing the discharge with a pulse width which is less than 70 microseconds and at less than 30 amps as appropriate for this process, so it would have been obvious to a person of ordinary skill in the art at the time of invention to modify '427 to use these parameters (**claims 107 and 115**).

23. **Claims 91-94 and 96-99** are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 76-78, 105



and 106 of copending Application No.10/559427 (hereafter referred to as '427) in view of Saito further in view of Imai.

'427 in view of Saito does not teach using powder with average size particles 10-1000nm in diameter, however, as discussed in the prior art rejection of claim 91 previously, Imai teaches that diameter of the particles is a result effective variable which should be optimized in order to produce the desired thickness and quality of the resulting film.

Thus it would have been obvious to a person of ordinary skill in the art at the time of invention to optimize the average particle size of the powder of '427 in view of Saito to be within the claimed range by routine optimization in order to produce the desired quality and thickness of the film (**claim 91**). '427 does not specifically teach using more than 80% of the powder in the claimed range. However, as discussed in the previous rejection of 96, Saito teaches using a single powder as a suitable electrode for forming desirable films, so it would have been obvious to a person of ordinary skill in the art at the time of invention to modify the process of '427 to use a single powder electrode, which would then have the required diameter powder to be more than 80% of the powder, since it was a known desirable use for the process which would produce predictable results (**claim 96**). Regarding **claims 92 and 97**, '427 does not teach that their medium is a machining fluid or a gas atmosphere. However, as discussed previously in the prior art rejection of claims 92 and 97, Saito teaches that a gas atmosphere is a suitable environment in which to perform this process. Thus it would have been obvious to a person of ordinary skill in

the art at the time of invention to use a gas atmosphere as the machining medium, since it was known to be suitable for that purpose and would produce predictable results. Regarding **claims 93 and 98**, '427 does not teach using this deposition parameters, however as discussed in the prior art rejection of claims 107 and 115, Saito teaches performing the discharge with a pulse width which is less than 70 microseconds and at less than 30 amps as appropriate for this process, so it would have been obvious to a person of ordinary skill in the art at the time of invention to modify '427 to use these parameters. Regarding **claims 94 and 99**, the powder of '427 is taught to be a metal.

24. **Claims 101 and 109** are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 76-78, 105 and 106 of copending Application No.10/559427 (hereafter referred to as '427) in view of Saito in view of Koizumi.

'427 in view of Saito does not teach grinding the powders to produce the desired refined size, however, as discussed in the rejection of these claims above, Koizumi teaches grinding the powders and so renders it obvious to a person of ordinary skill in the art at the time of invention to use powders that have been ground, since they were known to be suitable and would produce predictable results.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

25. **Claims 90, 95, 100, 102-106, 108 and 110-114** are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable

over claims 46, 51 and 52 of copending Application No.10/516506 (hereafter referred to as '506) in view of Saito. Although the conflicting claims are not identical, they are not patentably distinct from each other because these claims teach the limitations of claims 90 and 95 except for explicitly stating that the electrode is uniform, the particle diameter is 10-3000nm in diameter and that the process is capable of forming 100 micron thick films.

This process is capable of forming films 100 micrometers in diameter.

'506 does not teach using different powders of the required diameters, compositions and proportions. However, as discussed in the prior art rejection of claims 100 previously, Saito makes these limitations obvious, so it would be obvious to a person of ordinary skill in the art at the time of invention to modify '506 to produce these limitations in view of Saito (**claims 90, 95, 100, 102-106, 108 and 110-114**). As discussed in the prior art rejection of claims 107 and 115, Saito teaches performing the discharge with a pulse width which is less than 70 microseconds and at less than 30 amps as appropriate for this process, so it would have been obvious to a person of ordinary skill in the art at the time of invention to modify '506 to use these parameters (**claims 107 and 115**).

26. **Claims 91-94 and 96-99** are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 46, 51 and 52 of copending Application No.10/516506 (hereafter referred to as '506) in view of Saito further in view of Imai.

'506 in view of Saito does not teach using powder with average size particles 10-1000nm in diameter, however, as discussed in the prior art rejection of claim 91 previously, Imai teaches that diameter of the particles is a result effective variable which should be optimized in order to produce the desired thickness and quality of the resulting film.

Thus it would have been obvious to a person of ordinary skill in the art at the time of invention to optimize the average particle size of the powder of '506 in view of Saito to be within the claimed range by routine optimization in order to produce the desired quality and thickness of the film (**claim 91**). '506 does not specifically teach using more than 80% of the powder in the claimed range. However, as discussed in the previous rejection of 96, Saito teaches using a single powder as a suitable electrode for forming desirable films, so it would have been obvious to a person of ordinary skill in the art at the time of invention to modify the process of '506 to use a single powder electrode, which would then have the required diameter powder to be more than 80% of the powder, since it was a known desirable use for the process which would produce predictable results (**claim 96**). Regarding **claims 92 and 97**, '506 does not teach that their medium is a machining fluid or a gas atmosphere. However, as discussed previously in the prior art rejection of claims 92 and 97, Saito teaches that a gas atmosphere is a suitable environment in which to perform this process. Thus it would have been obvious to a person of ordinary skill in the art at the time of invention to use a gas atmosphere as the machining medium, since it was known to be suitable for that purpose and would produce predictable

results. Regarding **claims 93 and 98**, '506 does not teach using this deposition parameters, however as discussed in the prior art rejection of claims 107 and 115, Saito teaches performing the discharge with a pulse width which is less than 70 microseconds and at less than 30 amps as appropriate for this process, so it would have been obvious to a person of ordinary skill in the art at the time of invention to modify '506 to use these parameters. Regarding **claims 94 and 99**, the powder of '506 is taught to be a metal.

27. **Claims 101 and 109** are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 46, 51 and 52 of copending Application No.10/516506 (hereafter referred to as '506) in view of Saito in view of Koizumi.

'506 in view of Saito does not teach grinding the powders to produce the desired refined size, however, as discussed in the rejection of these claims above, Koizumi teaches grinding the powders and so renders it obvious to a person of ordinary skill in the art at the time of invention to use powders that have been ground, since they were known to be suitable and would produce predictable results.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JOEL G. HORNING whose telephone number is (571)

270-5357. The examiner can normally be reached on M-F 9-5pm with alternating Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael B. Cleveland can be reached on (571)272-1418. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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/J. G. H./  
Examiner, Art Unit 1792

/Michael Cleveland/  
Supervisory Patent Examiner, Art Unit 1792